

This Opinion is Not a
Precedent of the TTAB

Hearing: March 16, 2023

Mailed: June 27, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re SLC Hauppauge Development, LLC
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Serial No. 90562295
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Jordan Arnot Leahey of Culhane Meadows PLLC,
for SLC Hauppauge Development, LLC.

Dannean J. Hetzel, Trademark Examining Attorney, Law Office 106,
Mary I. Sparrow, Managing Attorney.

—
Before Wolfson, Coggins and Hudis,
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

SLC Hauppauge Development, LLC (“Applicant”) seeks registration on the
Principal Register of the standard character mark CARLOW for:

Business center services, namely, providing office facilities and leasing
of office supplies and equipment and providing facilities for the use of
business supplies and office equipment, in International Class 35;

Real estate services, namely, rental, brokerage, leasing and
management of residential and commercial property, offices and office
space, and real estate, in International Class 36;

Real estate property cleaning, repair and maintenance services, in
International Class 37;

Parking garage services; Valet Parking; Chauffeur services; Chauffeur driven car hire services, in International Class 39;

Fitness centers, namely, providing facilities for physical fitness training; providing swimming pools; recreational services in the nature of swimming pools; Providing facilities for social and recreational activities, namely, lounge areas, in International Class 41; and

Providing general purpose facilities for social gatherings, parties, business meetings, in International Class 43.¹

The Trademark Examining Attorney refused registration under Trademark Act Section 2(e)(4), 15 U.S.C. § 1052(e)(4), on the ground that Applicant's mark, as applied to the services identified in the application, is primarily merely a surname.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. The appeal is fully briefed, and an oral hearing was held March 16, 2023. We reverse the refusal to register.

I. Evidentiary Issues

Before proceeding to the merits of the refusal, we address a number of evidentiary matters. Appended to Applicant's Brief, are the following exhibits:

Exhibit A: Results of a search on WIKIPEDIA for the term CARLOW.

Exhibit B: Web page capture for Carlow University.

Exhibit C: MERRIAM-WEBSTER online dictionary definition of the term CARLOW.

Exhibit D: Excerpts from slides that a branding agency presented to Applicant regarding the proposed adoption of CARLOW as a mark for Applicant's business.

Exhibit E: Web page capture from the website HowManyOfMe.com for the term CARLOW.

¹ Application Serial No. 90562295 was filed on March 5, 2021, under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), based upon Applicant's allegation of a bona fide intention to use the mark in commerce.

Exhibit F: Web page capture from the website ThinkBabyNames.com for “Boy Names Starting with Car-”.

Exhibit G: Web page capture from the website ThinkBabyNames.com for “Girl Names Starting with Car-”.²

Applicant requests that we take judicial notice of Exhibits A-C and E-G.³ The Examining Attorney requests that we reject, and thus decline to consider, Exhibits A-D and F-G as having been untimely filed, and that we decline Applicant’s request for judicial notice.⁴ Exhibit E, the HowManyOfMe.com material, previously was made of record during prosecution.⁵

The record in an application should be complete before the filing of an appeal. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); *In re tapio GmbH*, 2020 USPQ2d 11387, at *4 (TTAB 2020). Any request to supplement the record thereafter must be addressed through a separately filed and captioned written request to the Board for a remand to introduce additional evidence based on good cause. Trademark Rule 2.142(d). Therefore, unless we exercise our discretion to take judicial notice of any of Applicant’s late-filed items, we decline to consider these materials that are not part

² Exhibits A-G appended to Applicant’s Brief, 7 TTABVUE 21-44. Page references herein to the application record refer to the online database of the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system. All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer. References to the briefs on appeal refer to the Board’s TTABVUE docket system. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable.

³ Applicant’s Brief, 7 TTABVUE 12-13, nn.3-4; 7 TTABVUE 15, n.6; 7 TTABVUE 16, n.7; and 7 TTABVUE 17, n.8.

⁴ Examining Attorney’s Brief, 9 TTABVUE 3-5.

⁵ Web page capture from HowManyOfMe.com for term CARLOW, Office Action Response of March 23, 2022, at 17-19.

of the prosecution record. *In re Taverna Izakaya LLC*, 2021 USPQ2d 1134, at *3 (TTAB 2021).

The Board may take judicial notice of a fact that is “not subject to reasonable dispute because it: (1) is generally known within the trial court’s territorial jurisdiction; or (2) can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned.” Fed. R. Evid. 201(b). See TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) §§ 704.12(a) and 1208.04 (2022) (and authorities cited therein); see also *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1723 (TTAB 2008) (evidence regarding whether items of outerwear and undergarments are related not judicially noticeable); *Standard Knitting Ltd. v. Toyota Jidosha K.K.*, 77 USPQ2d 1917, 1931 n.26 (TTAB 2006) (third-party website materials not judicially noticeable). Under this framework, we decline to take judicial notice of the following exhibits to Applicant’s Brief that do not fall within the ambit of Fed. R. Evid. 201(b), and therefore we do not consider them: Exhibit A (WIKIPEDIA search results); Exhibit B (web page capture for Carlow University); Exhibit D (excerpts from slides of Applicant’s branding agency); and Exhibits F-G (web page captures from ThinkBabyNames.com).

The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. See *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016). We therefore take judicial notice of Exhibit C to Applicant’s Brief (MERRIAM-WEBSTER online dictionary definition of CARLOW) and

will consider it. *See, e.g., In re Well Living Lab Inc.*, 122 USPQ2d 1777, 1780 n.9 (TTAB 2017) (judicial notice taken of definition attached to an applicant's appeal brief).

As noted, Exhibit E to Applicant's Brief (web page capture from HowManyOfMe.com) was already made of record during prosecution. The Board discourages the practice of presenting evidence twice. *In re Lorillard Licensing Co.*, 99 USPQ2d 1312, 1315 (TTAB 2011); *In re SL&E Training Stable Inc.*, 88 USPQ2d 1216, 1220 n.9 (TTAB 2008) (attaching as exhibits to brief material already of record requires Board to determine whether attachments had been properly made of record and adds to the bulk of the file); *In re Thor Tech Inc.*, 85 USPQ2d 1474, 1475 n.3 (TTAB 2007) (attaching evidence from record to briefs is duplicative and is unnecessary). We consider only the HowManyOfMe.com evidence that was timely made of record during prosecution.

II. Applicable Law: "Primarily Merely a Surname"

Trademark Act Section 2(e)(4) provides that, absent a showing of acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f),⁶ registration on the Principal Register must be refused if the proposed mark is "primarily merely a surname." A term is primarily merely a surname if, when viewed in relation to the goods or services for which registration is sought, its primary significance as a whole to the purchasing public is that of a surname. *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d

⁶ As noted, the CARLOW application was filed based on Applicant's intent to use the mark in commerce, and Applicant has not made of record any evidence that it has begun using the mark. Consequently, Applicant has not presented any evidence or argument that the CARLOW mark has acquired distinctiveness.

1374, 123 USPQ2d 1411, 1413 (Fed. Cir. 2017); *In re tapio*, 2020 USPQ2d 11387, at *8; *In re Beds & Bars Ltd.*, 122 USPQ2d 1546, 1548 (TTAB 2017); *In re Eximius Coffee, LLC*, 120 USPQ2d 1276, 1277 (TTAB 2016).

“The statute provides that registration should be refused if the proposed mark is ‘primarily merely a surname.’ ‘Merely’ is synonymous with ‘only,’ and ‘primarily’ refers to ‘first in order’ or ‘fundamentally.’ Thus, we must determine whether ... [CARLOW] is fundamentally only a surname.” *In re Yeley*, 85 USPQ2d 1150, 1141 (TTAB 2007) (citing *In re I. Lewis Cigar Mfg. Co.*, 205 F.2d 204, 98 USPQ 265, 267 (CCPA 1953)).

Whether the primary significance of a proposed mark is merely that of a surname is a question of fact. See *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653-54 (Fed. Cir. 1985). There is no rule as to the kind or amount of evidence necessary to show that relevant consumers will perceive a term as primarily merely a surname. This question must be resolved on a case-by-case basis. *In re tapio*, 2020 USPQ2d 11387, at *8 (citing *In re Etablissements Darty et Fils*, 225 USPQ at 654); see also *In re Pohang Iron & Steel Co.*, 230 USPQ 79, 79 (TTAB 1986).

“[T]he [US]PTO has the initial burden of going forward in establishing that an applicant’s mark is primarily merely a surname. Only after the [US]PTO has presented a prima facie case that a mark is primarily merely a surname will the burden switch to the applicant to rebut this finding.” *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988). We examine the entire record to determine the primary significance of a term. *In re Olin Corp.*, 124 USPQ2d 1327,

1330 (TTAB 2017). If there is any doubt, we “are inclined to resolve such doubts in favor of applicant.” *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995).

We may consider various inquiries in determining whether the purchasing public would perceive a proposed mark as primarily merely a surname, including the following:

- (1) the rarity or frequency of exposure to the public of the mark being used as a surname;
- (2) whether anyone connected with the applicant has the mark as a surname;
- (3) whether the mark has any recognized meaning other than as a surname;
- (4) whether the mark has the structure and pronunciation of a surname; and
- (5) whether the manner in which the mark is displayed (such as by distinctive, stylized lettering) that might negate any surname significance.⁷

In re Colors in Optics, Ltd., 2020 USPQ2d 53784, at *1-2 (TTAB 2020) (citing *In re Benthin Mgmt.*, 37 USPQ2d at 1333-34 (TTAB 1995) for the *Benthin* inquiries/factors); *see also In re Eximius Coffee*, 120 USPQ2d at 1278 & n.4 (reviewing factors to be considered and noting there is no need to discuss inquiries for which the record lacks relevant evidence); *In re Adlon Brand GmbH & Co.*, 120 USPQ2d 1717, 1719, 1721 (TTAB 2016) (noting the consideration, if there is relevant supporting evidence of record, “of an alternative perceived meaning (which may include the perception of the mark as a coined term)”).

These inquiries are not exclusive, nor are they presented in order of importance; any of the inquiries—singly or in combination—as well as any other relevant circumstances, may shape the analysis in a particular case. *In re tapio*, 2020 USPQ2d

⁷ When the applied-for mark is not stylized, and it is not in this instance, it is unnecessary to consider the fifth inquiry. *In re Yeley*, 85 USPQ2d at 1151.

11387, at *9; *In re Olin*, 124 USPQ2d at 1330; *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1480 (TTAB 2017); *In re Integrated Embedded*, 120 USPQ2d 1504, 1506 n.4 (TTAB 2016). In making our determination, we weigh the inquiries together and accord the appropriate weight to each one based on the evidence of record. *In re Six Continents Ltd.*, 2022 USPQ2d 135, at *6 (TTAB 2022).

We conduct our analysis from the perspective of the purchasing public because “it is that impact or impression which should be evaluated in determining whether or not the primary significance of a word when applied to a product is a surname significance. If it is, **and it is only that**, then it is primarily merely a surname.” *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238, 239 (CCPA 1975) (emphasis original) (quoting *Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Comm’r Pat. 1955)).

III. Discussion of the Record and Analysis

A. The Rarity or Frequency of Exposure to the Public of CARLOW as a surname

We first consider the rarity of CARLOW or frequency of its exposure to the public being used as a surname. *Benthin*, 37 USPQ2d at 1332. In this regard, “[t]he relevant question is not simply how frequently a surname appears, ... but whether the purchasing public for Applicant’s [services] is more likely to perceive Applicant’s proposed mark as a surname rather than anything else.” *In re Beds & Bars*, 122 USPQ2d at 1551; *see also In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421, 422 (CCPA 1975) (same). In other words, the “strictly numerical approach

to a surname analysis has been squarely rejected” by the Board. *In re tapio*, 2020 USPQ2d 11387, at *11 (quoting *In re Adlon*, 120 USPQ2d at 1720-21).

Per the 2000 United States Census, at that time CARLOW as a surname had a usage incidence in the United States of 768 and its surname rank at the time was 29,069.⁸ According to the Forebears website, in 2014 CARLOW as a surname had a usage incidence in the United States of 1,206, and its rank at the time was 27,714.⁹

As reported by the How Many of Me website captured in 2022 (which is based on data obtained from the U.S. Census Bureau’s 1990 and 2000 censuses), there are 955 people in the United States with the surname Carlow. Statistically, according to this data, it is the 29,069th most popular surname. This same website reports there are fewer than 1,678 people in the United States with CARLOW as their first, or given, name. The estimate for this first name incidence is not absolute. The captured site explains that “[t]he list of names from the census bureau isn’t complete. ... [The site] do[es]n’t have exact data on less common names”¹⁰ The site also reports, on the date it was captured, that there were 335,536,629 people in the United States.

The Examining Attorney also made of record 22 entries of names and addresses of persons with the surname CARLOW in the United States from the Whitepages website. The Whitepages CARLOW search results were captured in 2022.¹¹ The Examining Attorney further provided LexisNexis public records search results for the

⁸ 2000 U.S. Census Data, Office Action Response of March 23, 2022, at TSDR 15.

⁹ Forebears website, Office Action of January 20, 2022, at TSDR 12.

¹⁰ How Many of Me website, Office Action Response of March 23, 2022, at TSDR 17-19.

¹¹ Whitepages web pages, Office Action of April 21, 2022, at TSDR 14-19.

surname CARLOW. The results show that 1019 entries were found, of which the Examining Attorney provided 200.¹² However, Applicant makes a persuasive argument that “[t]he ... [Examining Attorney’s] evidence contains duplicates, so the number relied upon by the ... [Examining Attorney] is greater than what there actually must be.”¹³ While acknowledging Applicant’s critique of the LexisNexis evidence, the Examining Attorney makes no effort to address it.¹⁴

To support its argument that the current appeal is comparable to the Board’s prior decision in *In re Joint-Stock Co. “Baik”*, 84 USPQ2d 1921 (TTAB 2007), Applicant made of record other data from the 2000 United States Census, indicating that at that time BAIK as a surname had a usage incidence in the United States of 952 and its surname rank was 24,598.¹⁵ The Board, in *“Baik”*, 84 USPQ2d at 1922, based on information made of record from two databases (Verizon superpages.com and LexisNexis), found BAIK to be rare as a surname, and based on the record as a whole the Board reversed the Trademark Act Section 2(e)(4) surname refusal. From this, Applicant argues CARLOW is just as rare a surname as is BAIK.¹⁶

While we avoid a strictly numerical approach to the present surname analysis, *In re tapio*, 2020 USPQ2d 11387, at *11, upon our review of the evidence discussed above as a whole, as well as the lack of other evidence demonstrating exposure of CARLOW

¹² LexisNexis search results, Denial of Request for Reconsideration, July 27, 2022, at TSDR 5-24.

¹³ Applicant’s Brief, 7 TTABVUE 10, n.2.

¹⁴ Examining Attorney’s Brief, 9 TTABVUE 6.

¹⁵ 2000 U.S. Census Data for “BAIK,” Office Action Response of March 23, 2022, at TSDR 21.

¹⁶ Office Action Response of March 23, 2022, at TSDR 7.

to the public, we find that CARLOW as a surname is rare. Out of a country of over 330 million people, the incidence of CARLOW as a surname hovers only around 1,000; and there is evidence of record that the incidence of CARLOW as a first or given name is above that.

B. Whether Anyone Connected with Applicant has CARLOW as a Surname

During prosecution, Applicant represented that no person connected with it has the surname CARLOW.¹⁷ Applicant repeated this representation on appeal.¹⁸ The Examining Attorney acknowledged this fact (i.e., “[t]he [E]xamining [A]ttorney does not directly dispute this”) and acknowledged “this point weighs in [A]pplicant’s favor”¹⁹

C. Whether CARLOW has any Recognized Meaning other than as a Surname

The record before us shows that CARLOW has recognized meanings and associations other than as a surname. As we noted above, the How Many of Me website reports a not-insignificant incidence of people in the United States with CARLOW as their first or given name, potentially greater than the incidence of CARLOW as a surname.²⁰

Further, the MERRIAM-WEBSTER online dictionary reference that Applicant attached to its brief, and of which we take judicial notice, defines CARLOW as a

¹⁷ Office Action Response of March 23, 2022, at TSDR 8.

¹⁸ Applicant’s Brief, 7 TTABVUE 9.

¹⁹ Examining Attorney’s Brief, 9 TTABVUE 7.

²⁰ How Many of Me website, Office Action Response of March 23, 2022, at TSDR 17-19.

“geographical name;” that is, a “county of southeastern Ireland in the province of Leinster” and a “town, [which is the] capital of the Irish county of Carlow.”²¹ The Forebears website also notes the geographic origins of CARLOW, as in “(Celtic) belonging to Carlow = the Quadruple Lake [Irish Cetherloch – cether, four, loch, lake].”²² A captured page from the SurnameDB website states that CARLOW “may also be a topographical name deriving from the old English pre 7th century ‘carr’ meaning ‘rock’, ‘stone’ plus ‘hlaew’, ‘burial mound’ (sometimes used as meeting-places).”²³

From this evidence, we find that CARLOW has meanings other than as a surname; that is, as a first or given name and as a geographical name.

D. Whether CARLOW has the Structure and Pronunciation of a Surname

The structure and pronunciation surname inquiry “is decidedly subjective in nature.” *In re Benthin*, 37 USPQ2d at 1333; *see also In re Eximius Coffee*, 120 USPQ2d at 1280 (whether a term has the structure and pronunciation of a surname is a “decidedly subjective” inquiry).

Evidence that the public would perceive a term to have surname significance due to its structure or pronunciation can include a comparison of the mark at issue to other common surnames that are configured similarly and sound similar. *In re tapio*, 2020 USPQ2d 11387, at *12 (citing *In re Eximius Coffee*, 120 USPQ2d at 1280)). In

²¹ MERRIAM-WEBSTER definition of CARLOW, Applicant’s Brief, 7 TTABVUE 27.

²² Forebears website, Office Action of January 20, 2022, at TSDR 13.

²³ SurnameDB website, Office Action of April 21, 2022, at TSDR 11.

such cases, the USPTO must provide evidence showing that the public would likely perceive the mark as a surname due to the similar structure and pronunciation, such as evidence that the terms to which the mark is being compared are common surnames to which the public has been exposed. *In re Eximius Coffee*, 120 USPQ2d at 1280.

For example, in *In re Bed & Bars*, 122 USPQ2d at 1551, the Board required evidence bearing on how members of the public would perceive the structure and sound of BELUSHI and whether they would be likely to perceive the proposed mark as similar or dissimilar in structure and sound to other surnames, common words, or coined terms. *See also In re Adlon Brand*, 120 USPQ2d at 1724 (noting that “[t]he mere sharing of a prefix, suffix or letter string does not result in the sort of structural similarity that is helpful to [the surname] analysis” and that arguments about surname structure and pronunciation “would require more objective evidence ... of how members of the public would perceive the structure and sound of [the applied-for mark] and whether they would be likely to perceive it as similar to the structure and sound of other surnames, common words or coined terms”).

On the structure and pronunciation part of the surname inquiry, without specifically citing to relevant portions of the prosecution record, the Examining Attorney tautologically says that “[t]he existence of CARLOW in the various surname databases and telephone directories demonstrates that this word has the look and feel of a surname because it appears as a surname in surname databases and

telephone directory listings.”²⁴ This argument is not informative or persuasive. We therefore review the relevant parts of the prosecution record to discern whether there is any evidence relevant to the structure and pronunciation inquiry.

The House of Names website says that “[s]pelling variations of the name Carlow include Carle, Carley, Carlley, Carrley, Carlie, Carleigh, Carlea, Carlee, Carrlie, Carlies, Carleys, Carleas, Carlay, Carley, Carrlay, Carrley, Carrleys, [and] Karley ...”²⁵ This evidence is not helpful, because many of these examples have the structure and pronunciation of first or given names as much as surnames. Slightly more helpful, the Forebears website identifies the following as “[p]honetically similar [sur]names” to CARLOW: “Charlow, Carlowe, Carllow, Carlaw, Carlov, Carlob, [and] Corlow.” However, according to the site, only Charlow, Carllow, and Carlow have any degree of prevalence in the United States.²⁶ The SurnameDB website identifies “Carlow, Carlo [and] Carlaw [as] dialectal variant[s] of the locational names Callow in Derbyshire and Hertfordshire, deriving from the old English pre 7th Century ‘calu’ meaning ‘bere’ plus ‘hlaw’ ‘hill’, hence ‘bare hill’, or Calow in Derbyshire, deriving from the old English pre 7th Century ‘calu’ plus ‘halh’ meaning ‘corner of land’, ‘water meadow’.”²⁷ Thus, even the origins of CALOW are geographic in nomenclature.

The SurnameDB website does not provide any evidence of the degree of prevalence of the various dialectal variants of Carlow as a surname in the United States; instead,

²⁴ Examining Attorney’s Brief, 9 TTABVUE 9.

²⁵ House of Names website, Office Action of January 20, 2022, at TSDR 6.

²⁶ Forebears website, Office Action of January 20, 2022, at TSDR 18.

²⁷ SurnameDB website, Office Action of April 21, 2022, at TSDR 11.

it provides context for the variants almost exclusively in England.²⁸ Similarly, while the Your Family History website indicates “Carlaw” as a surname variant to CARLOW, this entire website reference is a discussion of the “Carlow Name Origin, Meaning and Family History” within England and Wales. These references thus tell us nothing about consumer perceptions in the United States. *See In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1596 (TTAB 2018) (“While evidence of foreign use may in some cases be probative, in this case it does not serve to tell us the norms specific to pet owners in the United States, who are the relevant consumers.”).

The Examining Attorney also made of record 13 third-party registrations of marks having surname connotations, all of which were registered either with a claim of acquired distinctiveness pursuant to Trademark Act Section 2(f) (in whole or in part) or on the Supplemental Register: CARLOW UNIVERSITY (Reg. No. 3479261, claiming the benefits of Trademark Act Section 2(f) as to “Carlow”), CARLOW (Reg. No. 3479262, 2(f) as to the entire mark),²⁹ BRODSKY (Reg. No. 4040600, 2(f) as to the entire mark), INGLOT (Reg. No. 4668861, Supplemental Register), CLARIDGE’S (Reg. No. 4820689, 2(f) as to the entire mark), COOPER (Reg. No. 5724532, 2(f) as to the entire mark), GALLAGHER (Reg. No. 5694350, 2(f) as to the entire mark), WALSH (Reg. No. 5817997, 2(f) as to the entire mark, IZER (Reg. No. 6060673, Supplemental Register), MOORECO (Reg. No. 5843470, 2(f) as to the entire mark),

²⁸ The only reference of the name associated with the United States is the single sentence that “One David Carlow, aged 20 yrs., a famine emigrant, sailed from Liverpool aboard the ‘Howard’ bound for New York on May 18th 1847.” *Id.*

²⁹ Third-party registrations, Office Action of April 21, 2022, at TSDR 20-25.

LOEWS HOTELS (Reg. No. 6161857, 2(f) as to “Loews”), MARTIN (Reg. No. 6173086, 2(f) as to the entire mark), and FRANKEL (Reg. No. 6458800, 2(f) as to the entire mark).³⁰

We do not find these third-party registrations helpful to our analysis for a number of reasons. First, except for the CARLOW UNIVERSITY and CARLOW registrations (owned by the same registrant), none of the third-party registrations pertain to marks that are configured similarly or sound similar to the CARLOW mark at issue. *In re tapio*, 2020 USPQ2d 11387, at *12.

Second, the USPTO’s decisions to allow the cited third-party marks to register pursuant to Trademark Act Section 2(f) or on the Supplemental Register pertain to prosecution records and registration conditions of which the consuming public is not aware. *Cf. In re Dimarzio, Inc.*, 2021 USPQ2d 1191, at *23 (TTAB 2021) (“[W]e cannot assume that consumers of Applicant’s goods will be aware that Applicant restricts its use to a particular type of electronic sound guitar pickup as mentioned in the description of the mark”); *In re Dolce Vita Footwear, Inc.*, 2021 USPQ2d 479, at *11 (TTAB) (“We cannot assume that consumers of Applicant’s goods will be aware that its identification is so restricted [to exclude transparent goods], and the restriction is not controlling of public perception [of the applicant’s goods sold under the CLEAR mark].”), *appeals docketed*, Nos. 21-2114, -2115 (Fed. Cir. July 1, 2021); *In re Wada*, 48 USPQ2d 1689, 1692 (TTAB 1998) (public is unaware of disclaimers

³⁰ Additional third-party registrations, Denial of Request for Reconsideration of July 27, 2022, at TSDR 25-70.

that “quietly reside” in the records of the Office), *aff'd*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999).

Third, “[t]he Board must decide each case on its own merits. ... Even if some prior registrations had some characteristics similar to ... [the CARLOW] application [now before us], the [US]PTO’s allowance of such prior registrations [with the USPTO’s conditions for such registrations] does not bind the Board ...” *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

In sum, the evidence made of record does not persuade us that CARLOW necessarily has the structure and pronunciation of a surname.

IV. Weighing the Evidence of Record: “Primarily Merely a Surname”

Weighing the proofs made of record, the incidence of CARLOW as a surname in the United States is rare. No one connected with Applicant has the surname CARLOW. There is evidence in the record that CARLOW has recognized meanings other than as a surname: first, as a given name with the same and possibly greater incidence in the United States than as a surname; second, as a geographical name. The record also is not sufficiently persuasive so as to demonstrate that CARLOW has the structure and pronunciation of a surname.

On balance, we find that while the Examining Attorney originally made a prima facie case that CARLOW is primarily merely a surname, Applicant sufficiently rebutted the Examining Attorney’s evidence such that “we ... resolve doubts in favor of ... [A]pplicant and pass the mark to publication with the knowledge that others who have the same surname and use it or wish to use it for the same or similar ... services can file a notice of opposition.” *In re Benthin*, 37 USPQ2d at 1334; *see also In*

re S. Oliver Bernd Freier GmbH & Co. KG, 20 USPQ2d 1878, 1879 (TTAB 1991) (“[I]n this case ... OLIVER [within the mark S. OLIVER] is a given name as well as a surname and it appears that the given name significance is as well[-]known as the surname meaning. ... There is, therefore, a certain ambiguity present in this mark so that it cannot be predicted whether the perception of the consuming public would be as a surname or a given name. In view thereof, we will resolve that doubt in favor of the applicant.”).

Decision:

The refusal to register Applicant’s mark CARLOW as primarily merely a surname under Trademark Act Section 2(e)(4) is reversed.